

Attorney Docket No. 740756-2724

Application No. 10/827,534

Page 16

REMARKS

By the present response, claims 1-36 and 57-62, 64-68, and 70-75 are amended and claims 49-54, 63, 69 and 76 are canceled. Claims 1-36, 57-62, 64-68 and 70-75 shall be pending upon entry of this response. The amendments are supported by Applicant's original disclosure, for example, page 10, lines 15-19 and page 11, line 25 to page 14, line 15 of the specification. In view of the forgoing amendments and the remarks advanced below, Applicant respectfully requests reconsideration and withdrawal of the rejection of the claims.

Page 2 of the final Office Action includes the following statements in response to Applicant's arguments presented on pages 14-16 of the March 20, 2006, response:

Referring to applicant's arguments of the use of a photoresist mask to etch a part of a conductive layer. Edwards discloses the use of the photoresist mask to etch a conductive layer forming a pattern. This technique is a VERY standard technique and notoriously well known to one of ordinary skill. Please refer to the previous response to arguments in the previous office action dated 12/20/2005, which lists numerous patents that disclose the use of a photoresist mask to etch a conductive layer. All arguments considering the novelty of the use of a photoresist mask to etch are considered moot.

First of all, it is submitted that Applicant's arguments are not "moot," as the Examiner purports them to be. Indeed, the rejections were maintained in the final Office Action. Second, the Examiner's overly broad statements, above, clearly are not commensurate with Applicant's remarks set forth in the March 20, 2006, response. For instance, Applicant's response did not argue novelty and nonobviousness simply with respect to use of a photoresist mask to etch a part of a conductive layer. Rather, page 14 of Applicant's response argued the following:

Furthermore, it is respectfully submitted that it is the Office's burden for establishing an *prima facie* case of obviousness, and that the conclusory statement made on page 3 of the Action asserting that the ten patents listed therein allegedly teach the processes of "etching a part of the conductive film by using the resist mask" and "etching a part of the etched conductive film," as recited in claim 1 and similar subject matter recited in claim 3, is improper if not only for failing to point out where each of these documents teach the combinations of specific claimed features, but also because they are not cited in connection with any rejection based on the patent statutes. For these reasons, Applicant requests the Examiner to formally withdraw the statements in the Response to Arguments.

It is the Office's burden, not Applicant's, to establish a *prima facie* case. See MPEP § 2142, which instructs, "The Examiner bears the initial burden of factually supporting any *prima*

Attorney Docket No. 740756-2724
Application No. 10/827,534
Page 17

facie conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” Moreover, the Examiner still has not shown where the applied prior art teaches the specific combination of processes relating to “etching a part of the conductive film by using the resist mask” and “etching a part of the etched conductive film,” as set forth in combination with the other features of claim 1, and similar subject matter recited in claims 2, 5 and 57. Applicant’s arguments related to these feature are not moot and remain unanswered. Incidentally, it should be noted that if the Examiner’s apparent standard for nonobviousness were to be considered proper under the purveyance of the patent laws (e.g., Sections 102 and 103) (which it is not), much subject matter patented since 1965 (i.e., when the Edwards et al. patent issued), would never have been issued in the field of semiconductor device fabrication.

Also, Applicant’s arguments spanning pages 15-16 of Applicant’s response, which concern the features of “removing a portion of the resist by etching an entire surface of the resist to form a resist mask,” as recited in independent claims 1-6, also have not been answered.

Furthermore, the Examiner fails to address Applicants arguments advanced on page 16 in connection with the features of “wherein each source electrode and drain electrode is in contact with a side surface and an upper surface of the semiconductor region,” as recited in claims 57, 64 and 70. At page 21, lines 6 to 8 of the most recent Office Action, the Examiner asserts that Figure 1E of the Zhang patent shows electrodes 118 and 116 in contact with an upper and side surface of “the semiconductor region.” However, contrary to the Examiner’s allegations, Figure 1E of Zhang does not show a side surface of the semiconductor region in contact with the electrodes 118 and 116.

For at least these reasons, the Zhang and Edwards patents, whether considered individually or in combination, fail to teach or suggest Applicant’s claimed subject matter. However, in hopes of advancing the prosecution to prompt allowance, and since it appears Applicant’s previous arguments will never be addressed, Applicants have amended the claims. Amended claim 1 now recites, among other features, forming sidewalls, etching the gate insulating film by using the sidewalls, and removing an entire upper portion of the resist. Claims 2-6, 57, 64 and 70 are amended in a similar manner. In addition to the distinctions discussed above, it is respectfully submitted that none of the applied documents, including

Attorney Docket No. 740756-2724

Application No. 10/827,534

Page 18

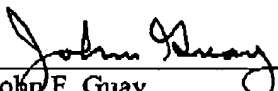
those cited in the December 20, 2005, Office Action, teach or suggest these features. Additionally, it appears that removing an entire portion of the resist (without using a photomask) is not taught or suggested by any of the applied references.

For all the above reasons, Applicant submits that independent claims 1-6, 57, 64 and 70 are allowable. As such, the rejection of these claims should be withdrawn.

Claims 7-36, 58-62, 65-68 and 71-75 depend either directly or indirectly from of independent claims 1-6, 57, 64 and 70, and are therefore allowable for at least the above reasons, and further for the additional features recited.

Based on the foregoing, the present application is believed to be in condition for allowance, and prompt notification of the same is earnestly sought.

Respectfully submitted,

By: 
John F. Guay
Registration No. 47,248

NIXON PEABODY LLP
401 9th Street, N.W., Suite 900
Washington, D.C. 20004-2128
(202) 585-8000 – Telephone
(202) 585-8080 – FAX